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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/571,733

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Patricia Imbach

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05/25/2010

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EXAMINER

STONE, CHRISTOPHER R

ART UNIT

PAPER NUMBER

1628

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |   |                                      |  |
|------------------------------|---|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/571,733    | <b>Applicant(s)</b><br>IMBACH ET AL. |  |
|                              | <b>Examiner</b><br>CHRISTOPHER R. STONE | <b>Art Unit</b><br>1628              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicants' arguments, filed February 24, 2010, have been fully considered but are moot in view of the new grounds of rejection below that were necessitated by Applicant's amendment. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### ***Status of Claims***

Claims 1-8 are pending and under examination. Compounds of formula I wherein R0, R1, and R2 are H, R3 is SO<sub>2</sub>N(H)<sub>0-1</sub>alkyl, R4, R5, and R6 are H, and R7, R8, and R9 are methoxy, such as the compounds shown in examples 56 and 58 of the specification are the elected species of compounds currently under examination.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-4 are drawn to a method comprising administering an agent for inhibiting ALK or a gene fusion thereof with a compound of formula I. While the specification teaches the administration of a compound of formula I with other agents (p. 25, last paragraph through p. 26, first paragraph), it is silent with regard to the administration of a compound of formula I with an agent for inhibiting ALK or a gene fusion thereof.

Furthermore, the specification discloses compounds of the narrow structural genus formula I (page 2) as agents for inhibiting ALK or a gene fusion thereof; however claims 1-4 are drawn to a method comprising administering any agent for inhibiting ALK or a gene fusion thereof. There is insufficient written description support for the genus, agent for inhibiting ALK or a gene fusion thereof.

The MPEP §2163 states that the purpose of the written description requirement is to ensure that the inventor had possession, as of the filing date of the application, of the specific subject matter later claimed by him. In the case of chemical entities, Applicant's attention is further directed to *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1568, 43 USPQ2d 1398 (Fed. Cir. 1997), *cert. denied*, 523 U.S. 1089, 118 S. Ct. 1548 (1998), which holds that an adequate written description requires a precise definition, such as by structure, formula, chemical name, or physical properties, "not a mere wish or plan for obtaining the claimed chemical invention." *Eli Lilly*, 119 F.3d at 1566. Furthermore, for a broad generic claim, the specification must provide adequate written description to identify the genus of the claim. Although the genus can be adequately described if the disclosure presents a sufficient number of

Art Unit: 1628

representative species that encompass the genus, if the genus has a substantial variance, the disclosure must describe a sufficient variety of species to reflect the variation within that genus. See MPEP § 2163. While the MPEP does not define what constitutes a sufficient number of representative species, the courts have indicated what does not constitute a representative number of species to adequately describe a broad generic. For example, in *In re Gostelli*, the courts determined that the disclosure of two chemical compounds within a subgenus did not describe that subgenus. *In re Gostelli*, 872, F.2d at 1012, 10 USPQ2d at 1618.

The Federal Circuit has adopted the standard set forth in the Patent and Trademark Office (PTO) Guidelines for Examination of Patent Applications under the 35 U.S.C. 112.I "Written Description" Requirement ("Guidelines"), 66 Fed. Reg. 1099 (Jan. 5, 2001), which state that the written description requirement can be met by "showing that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics," including, *inter alia*, "level of skill and knowledge in the art, partial structure, physical and/or chemical properties, functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention" *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 296 F.3d 316, 1324-25 (Fed. Cir. 2002) (quoting Guidelines, 66 Fed. Reg. at 1106). Disclosure of any combination of such identifying characteristics that distinguish the claimed invention from other materials and would lead one of skill in the art to the conclusion that the applicant was in possession of the claimed species is sufficient. MPEP §2163. However, if a biomolecule is described only by a functional

Art Unit: 1628

characteristic, without any disclosed correlation between function and structure of the sequence, it is “not sufficient characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence.” MPEP §2163.

Applicant has disclosed only compounds of the narrow structural genus formula I (page 2) as agents for inhibiting ALK or a gene fusion thereof. One of ordinary skill in the art cannot envision the structure of the compounds encompassed by the claimed genera. The instant specification is silent with regard to the structural features of said agents that correspond to the instantly claimed utility of the agents, i.e. the inhibition of ALK or a gene fusion thereof.

The MPEP states that written description for a genus, e.g. an agent for inhibiting ALK, can be achieved by a representative number of species within a broad generic. It is unquestionable that the claim(s) are broad and generic with respect to all possible compounds encompassed by the claims: the possible structural variations are limitless to any agents for inhibiting ALK or a gene fusion thereof (e.g. endogenous signaling molecules of differing structure, e.g. proteins/peptides, small synthetic organic molecules, etc.). In the instant case, however, the specification does not disclose a sufficient variety of species to reflect this variance in the genus. While having written description of the agents for inhibiting ALK or gene fusion thereof of formula I (page two of the instant specification), the specification does not provide sufficient descriptive support for the myriad of compounds embraced by the claims.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention.

Art Unit: 1628

See *In re Wilder*, 736, F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the specification does “little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.”) Accordingly, it is deemed that the specification fails to provide adequate written description for the genus of the claims and does not reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the entire scope of the claimed invention.

***Claim Rejections - 35 USC § 103***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being obvious over Baenteli et al (WO 03/078404) in view of Lilleyman et al (British Medical Bulletin, 52(4), p. 742-763, 1996).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome

Art Unit: 1628

by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Baenteli et al discloses a method of treating non-Hodgkin's lymphoma (NHL) comprising administering the elected species of compound optionally in combination with another compound of the formula of instant claim 1, e.g. compound 58 (p. 11, Table 2, Examples 56 and 59 and p. 27, lines 7, 8 and 32). Baenteli et al does not expressly teach anaplastic large-cell lymphoma as the particular specie of NHL or that a gene fusion containing ALK is inhibited.

Lilleyman et al teaches that anaplastic large-cell lymphoma is a class of NHL (p. 750, Table 1 and p. 757, first paragraph). Therefore it would have been prima facie obvious to one of ordinary skill in the art at the time of the instantly claimed invention to treat anaplastic large-cell lymphoma using the method of Baenteli et al, since Baenteli et al teaches that the method is useful in the treatment of NHL generically, anaplastic



Art Unit: 1628

large-cell lymphoma was a known class of NHL and one of ordinary skill in the art would have had a reasonable expectation of success in the treatment of any specie of lymphoma with the narrow genus of NHL, thus resulting in the practice of the instantly claimed invention with a reasonable expectation of success.

With regard to the wherein clauses of claims 4 and 8 specifying that a gene fusion containing ALK is inhibited, it is noted that the claim language merely specifies the intended result of a method step positively recited and is thus non-limiting.

Additionally, the mechanism of action (e.g. ALK inhibition) does not have a bearing on the patentability of the invention if the invention was already known or obvious. Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. In re Wiseman, 201 USPQ 658 (CCPA 1979). Granting a patent on the discovery of an unknown but inherent function would remove from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art. In re Baxter Travenol Labs, 21 USPQ2d 1281 (Fed. Cir. 1991). See M.P.E.P. 2145.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 1628

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER R. STONE whose telephone number is (571)270-3494. The examiner can normally be reached on Monday-Thursday, 7:30am-4:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1628

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRS

/Brandon J Fetterolf/  
Primary Examiner, Art Unit 1642